

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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Patent Application of:

Abraham THIJSEN et al.

Application No.: 10/654,487

Confirmation No.: 5210

Filed: September 4, 2003

Art Unit: 2164

For: A METHOD AND APPARATUS FOR  
MANAGING DOCUMENT DATA FOR  
EVENTUAL PRESENTATION TO A USER

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Examiner: R. Mahmood

**REPLY BRIEF ON APPEAL**

**MS AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

As required under § 41.41(a), this Reply Brief is filed within two months of the date of mailing of the Examiner's Answer.

In response to Appellants assertions that Chiba does not disclose selectively storing managed data information in a database in an intermediate representation, as recited, the Examiner's Answer, like the final Office Action, fails to explain where Chiba stores managed data information in a database, let alone in an intermediate representation in the database.

Instead, the Examiner's Answer merely argues that (1) the claims must be given their broadest reasonable interpretation; and (2) the intermediate representation is the state the data is in after being processed by the image reading device, i.e., after being scanned.

However, the argument that the claims are being given their broadest reasonable interpretation fails to explain why the precise language of claim 1, for example, which recites "acquiring the data from an appropriate document source in a source representation," and "selectively converting the data in source representation to data in destination representation, while

selectively storing in a database managed data in an intermediate representation," is disclosed by Chiba.

In this regard, Appellants respectfully submit that the Examiner's Answer fails to establish that Chiba's relied upon disclosure in col. 6, lines 15-33, col. 8, lines 1-12 and col. 11, line 18, does not even mention the words "database" or "managed data," and the Office cannot supply this deficiency merely by stating that the claims are given their broadest reasonable interpretation and that the state that the data is in, in Chiba's image data storing unit, constitutes managed data in a database.

In response to the Examiner's Answer's conclusion that it would be obvious to modify Chiba based on Takashi, Appellants respectfully point out that the Examiner's Answer completely fails to address, or in any way rebut, Appellants' detailed reasoning in support of its conclusion that Takashi is directed to a significantly different invention than Chiba, which is so different that these two references teach away from being combined, as suggested.

In this regard, Appellants respectfully argued in the Appeal Brief that Takashi is limited to (1) using a PC to determine in what format, image data has been stored in a camera memory, (2) determining the best format in which that data should be stored, determining whether the actual format in which the image data has been stored in the camera is the best format and, if it is not, then (3) converting the stored data in the camera memory to the best format and storing in the camera memory, the image data that has been converted to the best format. This conversion is done by Takashi's PC without instructions by a user.

Appellants also specifically argued that the Office Action never explains (1) what this has to do with Chiba's system, which does not deal with a camera, or with converting image data stored in the camera's memory to a best format, or (2) what a best format for storing image data in a camera memory has to do with Chiba's system.

In this regard, Appellants note that Chiba's system requires a user to specify the type of transferred data after conversion before it is converted, for the explicit purpose of eliminating the operations required for converting data after the data transfer.

Nor does the Office Action explain why one of ordinary skill in the art would be properly motivated to turn to such a system that is limited to automatically converting image data stored in a camera memory to a best format, to modify Chiba, which is directed to converting image data read by an image reading device to a separate different type of data to be displayed by a

display device, where a user is required to manually specify the converted image type before the conversion takes place.

Appellants also respectfully submitted that using Takashi's automatic conversion scheme which uses a predetermined "best" data format, in which to save an image taken by a camera in that camera's memory, bears no reasonable relation to Chiba's specifying converting a "document for eventual presentation" to a different format in which the document is to be eventually presented. This is so because Chiba requires a manual input of the output representation format, which clearly can and in practice does, differ from a best format and because of this, Takashi's automatic conversion scheme would fundamentally frustrate Chiba so as to be inoperative for its intended purpose, i.e., conversion to a user selected desired one of many possible output representation formats.

Furthermore, Appellants also specifically argued that (1) the Office Action never explains how Takashi's best format determination feature can be used to substitute for Chiba's user manual input feature, and that (2) one of ordinary skill in the art would not be motivated to substitute Takashi's best format determination and automatic conversion to a best format feature in Chiba because the so-modified version of Chiba would always convert to a single format with no way of knowing whether that format would be desired by Chiba's users.

Additionally, Appellants argued that Takashi's system merely chooses the best camera image storage format based on image quality or capacity, for example, and not on any image characteristic or parameter that has to be inputted by a user on an *ad hoc* basis, as is required by Chiba's system to function properly. For this reason, modifying Chiba in view of Takashi would result in a device that would not work for its intended purpose. Moreover, because Chiba requires user input prior to image format conversion regarding the converted image, whereas Takashi has no provision for this and is directed to a fundamentally different conversion, i.e., conversion of a camera image memory storage format regarding images taken by the camera.

In this regard, Appellants respectfully note that Chiba has nothing to do with conversion of a camera image storage format regarding images taken by a camera and, instead, is limited to conversion of image data that is already stored after having been imaged by an image reader, for example, into a user selectable format that is going to be reproduced.

The Examiner's Answer never fully addresses these specific, detailed arguments (in the eight preceding paragraphs, which were presented in Appellants' Appeal Brief) and instead,

merely responds (1) with the conclusionary statement that the claims have to be given their broadest reasonable interpretation, without presenting any specific interpretation(s) of the claim language in issue and (2) without explaining how giving the claims their broadest reasonable interpretation will explain why the references do not teach away from being combined with each other, which is directed to the issue of motivation to combines references and not to claim meaning.

The Examiner's Answer also cites a court decision for the general proposition that motivation to combine references can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

Unfortunately, the Examiner's Answer fails to explain where and how the references themselves provides such motivation or where and how the knowledge generally available to one of ordinary skill in the art provides such motivation, leaving it entirely to speculation and, thereby, tacitly agreeing with Appellants specific detailed arguments in support of the conclusion that Chiba and Takashi teach away from being combined, as suggested in the final rejection. It is well settled that a rejection under 35 U.S.C. § 103 cannot properly be based on speculation but must be based on objective factual evidence of record. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). See, also, *In re GPAC Inc.*, 35 USPQ2d 1116 at 1123 (Fed. Cir. 1995) and *Ex parte Haymond*, 41 USPQ2d 1217 at 1220 (Bd. Pat. App. & Int. 1996).

#### **NEW GROUND OF REJECTION:**

With respect to Appellants' previously presented assertions that (1) Veilleux, like Chiba, has no disclosure whatsoever of the claimed conversion on a dynamic trade-off basis between a first assessment and a second assessment while further considering one or more source profiles and one or more applicable destination profiles, or (2) the selectively concerting step converts data to a destination representation automatically without receiving a specification of a conversion form of the data in the destination representation from a user and, (3) Veilleux requires manual input from a user to download and convert the image characteristics to the color characteristics of the user (client), the Examiner's Answer never addresses Appellants' assertion (1), thereby tacitly agreeing with it.

With respect to Appellants' assertions (2) and (3), the Examiner's Answer only refers to

multiple portions of Veilleux' specification without explaining what language in those portions does not require manual input from a user to download and convert the image characteristics to the color characteristics of a user. In relied upon paragraph [0051], Veilleux clearly discloses that the color image server 18 retrieves an image that is requested (by a source client or a destination client – see paragraphs [0047] and [0049], for example). In relied upon paragraph [0064], Veilleux clearly discloses relying on a destination client request.

Now, for the first time, the Examiner, in the Examiner's Answer is relying on a portion of Veilleux that was never relied upon before. For the first time in the Examiner's Answer, the Examiner is relying on paragraph [0136] of Veilleux, which discloses that in an alternative embodiment, the user associated with a destination client may not even view pages sent by color profile server 20 for transfer of information following initial profiling, so that transfer of color correction information from color profile server 20 to a color image server happens automatically.

However, this allegedly automatic transfer of color correction information disclosed in paragraph [0136] of Veilleux is actually only semi-automatic in the sense that it involves input from the user and, thus, does not disclose what is claimed (which includes selectively converting the data in the source representation to the data in the destination representation based on an idiosyncratic destination profile of a destination apparatus represented by the destination representation automatically and without receiving a specification of a conversion form of the data in the destination representation from a user).

More specifically, paragraph [0136] of Veillieux only discloses a semi-automatic profiling in the sense that it requires an "initial profiling" and is only automatic after the initial profiling, which clearly involves input from a user to establish the profile cookie– see paragraph [0117], for example.

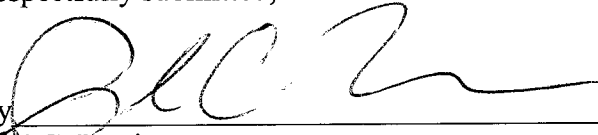
Thus, even if one of ordinary skill in the art were properly motivated to combine the three applied references, as suggested (which they would not be properly motivated to do for reasons presented above), the so-modified version of Chiba would clearly not result in, suggest, or otherwise render obvious, the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the claimed invention, and should be reversed.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: March 23, 2011  
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Respectfully submitted,

By \_\_\_\_\_

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